In response to the outstanding Office Action of September 6, 2007, in connection with the above-identified application, the following remarks are respectfully submitted. Favorable consideration of pending Claims 1-30, 48-51 and 58 is respectfully requested. Claims 31, 47, and 52-57 have been previously withdrawn.

Claims 1-30, 48-51 and 58 were rejected as failing to comply with the enablement requirement set forth in under 35 U.S.C. §112 ¶1. Examiner applied the factors presented by *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and concluded that a person having ordinary skill in the art would have to perform undue experimentation in order to make and use the invention, and therefore failed the statutory enablement requirement.

Applicants respectfully traverse this rejection, and further request that this rejection be reconsidered and withdrawn for at least the following two reasons: (1) because the rejection does not fully consider knowledge properly imputed to a person having ordinary skill in the art per current case law and (2) because the rejection improperly requires source code in the specification itself as an enabling disclosure, examiner misapprehends the enablement requirement. Accordingly, the Applicant respectfully submits that the facts of the present case have not been correctly applied to the *Wands* factors, and therefore do not establish undue experimentation.

Enablement Requires Imputing the Knowledge of a Skilled Programmer

The Court of Appeals for the Federal Circuit (hereafter "CAFC") has held that the level of one of ordinary skill for electrical/computer inventions is a skilled programmer. *Northern*

Telecom Inc. v. Datapoint Corp., 15 USPQ2d 1321 at 1330. Therefore, all the knowledge imputed to a skilled programmer, including but not limited to knowledge of XML, tags, and code generation, may be considered in enablement, not merely the explicit disclosure of the application's specification.

Applicant is not Required to Provide Source Code to Prevent Undue Experimentation

As stated above, regarding electrical/computer inventions (unlike the biotech invention in *Wands*), the CAFC has held that when the invention relates to a computer program, enablement is determined from the viewpoint of a skilled programmer, going on to state:

> In assessing any computer-related invention, it must be remembered that the programming is done in a computer language. The computer language is not a conjuration of some black art, it is simply a highly structured language . . . . [T]he conversion of a complete thought (as expressed in English and mathematics, i.e. the known input, the desired output, the mathematical expressions needed and the methods of using those expressions) into a language a machine understands is necessarily *a mere clerical function to a skilled programmer*. *Northern Telecom Inc. v. Datapoint Corp.*, 15 USPQ2d 1321 at 1330 (emphasis added).

Therefore, an application of a computer invention that has no or limited source code is not unenabled under 35 U.S.C. §112 ¶1 without an additional deficiency.

Wands Factors:

Applicant observes that *Wands* was decided in the context of a biotech patent application. The present application should be considered in terms of the electrical/computer arts. Applicant notes that the standard is not whether experimentation is required to practice

the invention, but rather if such experimentation is "undue." Applying the facts of the present case to the *Wands* factors, each of the factors either lowers the amount of disclosure required for enablement or extends the latitude of reasonableness for experimentation. Applicant responds to each of the *Wands* factors arguments in order presented by Examiner:

a) **Breadth:** Applicant respectfully submits that Breadth lowers the amount of disclosure necessary to enable a claim. Therefore, if, as asserted in the rejection, the rejected claims are broad, this standard has been misapplied in the rejection.

Additionally, Applicant submits that the rejection's comments regarding the Applicant's Appendix B from April 28, 2008 substituted an example in a definition for the definition itself. Appendix B is a technical definition of the term "layer" which happened to use the OSI model as an example of a layered architecture. It also used TCP/IP as an example of a two-layer set of programs. However, Applicant is *not asserting that all layered architectures are directed to network protocol stacks.*

Applicant submits that the rejected claims relates to an object-oriented software development environment in which takes advantage of the technique of "layers of abstraction" in which upper layers are implemented in terms of layers underneath them. This technique applies not only to network stacks, but also operating systems, and of course application frameworks.

In stating that the "invention was implemented as 'GEtheSource'", the rejection misquotes Applicant. Rather, as set forth in Applicant's statement of..., GEtheSource was

implemented using the invention. GEtheSource is not an object-oriented development environment, but rather is a web application created in part by the invention.

b) **The nature of the invention**: While the rejected claims may be implemented in the context of a software development system, it is noted that with regards to software, including in software development systems, experimentation in the form of iterating coding and debugging cycles is well-known, and expected by ordinary practitioners in order to practice a software invention. Software commonly is developed from general design specifications, some less detailed than Applicant's patent specification, but no less enabling. Therefore the standard of what constitutes unreasonable and therefore undue experimentation is lower, and the amount of disclosure necessary to enable the invention is lessened.

c) **The state of the prior art**: Assuming, *arguendo*, that object oriented software development platforms have been in existence several years before the present application was filed, as asserted in the rejection, this factor actually militates in favor of Applicant because more knowledge about object oriented software development platforms may be imputed to a person having ordinary skill in the art. Therefore the standard of what constitutes unreasonable and therefore undue experimentation is lower, and the amount of disclosure necessary to enable the invention is lessened.

d) **The level of one of ordinary skill**: Applicant respectfully submits that the rejection does not correctly state the standard for the level one of ordinary skill. The level of one of ordinary skill is not merely self-referential, but rather must be considered within the context of the

art. As stated above, here the level of one of ordinary skill for electrical/computer inventions is a skilled programmer.

e) **The level of predictability in the art:** Assuming, *arguendo,* that distributed systems and software generation is generally deterministic and therefore more predictable than biotechnology which *Wands* was directed to, as set forth in the rejection, this line of reasoning actually militates in favor of less specification rather than more specification. That is, because the electrical/computer arts are arguably more predictable, persons having ordinary skill in the art will require less, rather than more direction from Applicant.

f) **The amount of direction provided by the inventor:** Applicant respectfully submits that this factor is misapplied in the rejection by equating the specification with providing source code showing an actual implementation. The rejection states that because the pending application has limited source code in the specification, that the application is not enabled. The rejection goes on to call out the following examples: (1) login prompt on p. 57, (2) JavaScript login function in Table 5, (3) object abstracts in Tables 18-30, (4) HTML login source code snippet, (5) XML elements in Table 1, and (6) sample XML file for an asset catalog program in Table 2. However, as stated above, Applicant is not required to submit full source code. Still, for the sake of completeness, Applicant will address each of the cited source code examples as follows:

(1) the p. 57 login prompt is a sample input into the invention; (2) the JavaScript login in Table 5 is a sample output of the invention, (3) the object abstracts of Tables 18-30 list the specific custom tags and HTML extensions necessary to enable

automatic generation of source code, (4) the sample HTML login in page 94 is a sample input for localization, (5) the XML elements in Table 1 are reiterated (and in fact can be imputed to a person having ordinary skill in the art) to describe what tags and attributes require for XML compliance – since the invention comprises XML extended tags and attributes, and (6) the sample asset catalog XML file in Table 2 shows how the invention maps commands and views to interactions. The rejection objects to the sample code in Table 5 not referencing any other portion of the specification – but indeed it cannot, because it is just exemplary source code of output of the inventive concept. As stated above, implementations are not required. But far from not providing examples of the "implementations of the layers or domains" as required by the rejection, Applicant has provided numerous examples.

g) **The existence of working examples**: The rejection states that Applicant has "provided no working examples *to the Office for review*." However, Applicant respectfully submits that the standard is not whether Applicant provides a working example for review, but rather if a working example exists. As acknowledged in the rejection, Applicant has provided the office notice of "GEtheSource" which is "a web-based asset management application" that "incorporates logic that is related to the subject matter described in the present application" in remarks dated September 12, 2005. As stated above, GEtheSource is not the invention, but rather an output of the invention. To date, the Office has notified Applicant that previous 37 CFR 1.105 Requirement for Information is moot. Office Communication January 10, 2008.

h) **The quantity of experimentation needed to make or use the invention based on the content of the disclosure**: Applicant respectfully submits that the standard is not the quantity of experimentation to make or use the invention *based on the content of the disclosure*, but rather the quantity of experimentation to make or use the invention. If the standard were to be limited to the *content of the disclosure*, Applicant would be required to provide information well known in the art resulting in allegedly unenabled claims. For this reason, "A patent need not teach, and preferably omits, what is well known in the art." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); *and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

Conclusion

Applicant respectfully requests that Examiner withdraw 35 U.S.C. §112 ¶1 enablement rejection because, among other reasons, taking into account a skilled programmer's imputed knowledge of XML, tags, and code generation, provides sufficient information to practice the invention; because the status of software broadens the latitude of reasonable experimentation; and because explicit source code is not required to enable a software patent application,.
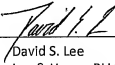
Applicant respectfully submits that Claims 1-30, 48-51 and 58 are now in condition for allowance. Applicant respectfully requests prompt allowance of the subject application. If any issue remains unresolved that would prevent allowance of this case, the Examiner is requested to contact the undersigned attorney to resolve the issue.

Respectfully Submitted,

Lee & Hayes, pllc

Date: _February 6, 2008_   By: _____

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